REMARKS

This amendment is responsive to the Final Office Action dated February 10, 2006. Applicant has amended claims 3–7, 10–15, 18, 39–42, 45 and 48, and canceled claims 25–31 and 38. Claims 1, 3–8, 10–24, 39–49, and 75–102 are pending.

Claim Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 1, 3–24, 48, 49, 75–98, 101 and 102 under 35 U.S.C. 103(a) as being unpatentable over Garber et al. (US 6,232,870) in view of Parulski et al. (US 5,633,678). Applicant respectfully traverses the rejection to the extent such rejections may be considered applicable to the claims as amended. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Claims 1, 8, 75, 76, and 83

In the Final Office Action, the Examiner stated that Garber et al. in view of Parulski et al. teaches the elements of claim 1, and in particular, teaches saving the categorized information in a database. As support for this assertion, the Examiner pointed to Parulski et al. as teaching image data and user-entered category information being stored on a removable storage device. Applicant respectfully submits that the Examiner's assertion of obviousness is based on a technical error.

With respect to storing category information, Paruluski specifically states:

> When the user selects a particular category, the category name is stored along with the image data **in the image file**, and any text and graphics logo, as appropriate, are overlaid onto the image[1].

Thus, Parulski makes clear that the category information for a particular image is stored within the image file itself. Each image is stored in a separate file, and the category name for each image is stored within that same image file. Thus, the Parulski system does not use a

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[1] Summary

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database at all, but rather requires **separate image files**. The Examiner's characterization of Parulski as using a database is incorrect and inconsistent with the plain teachings of Parulski.

Moreover, merely storing multiple, separate image files to a removable medium also fails to teach or suggest categorizing information obtained from an RFID tag and storing the categorized information in a database. A storage medium storing separate image files is **not** a database. While a database having categorized information may be stored to a removable storage device or a different storage device, it does not follow that a removable storage device of separate and distinct image files teaches or suggests a database having categorized information.

Modification of Garber in view of Parulski, as hypothesized by the Examiner, would at best result in an RFID system in which information captured from an RFID tag would be written to a removable storage medium as **separate files**, and each file would have category information, as specifically taught by Parulski

The image data described in Parulski et al. is not information that may be associated with categories and used to build a database. The image data of Parulski et al. is merely raw image data that is stored in separate files on a removable storage device. Moreover, the captured image data of Parulski et al. would not be stored in a database, as suggested by the Examiner, since the image data is typically too large for storage within a database. Instead, captured image data is typically stored as separate files, which is consistent with the specific teachings of Parulski.

For at least these reasons, Garber et al. in view of Parulski et al. fails to teach or suggest a method of collecting information related to RFID tags associated with items of interest in which in the information is categorized that then the categorized information is saved in a database, as required by independent claims 1, 8, and 75. The Examiner has failed to establish a prima facie case of obviousness with respect to these claims.

Further, Garber et al. in view of Parulski et al. fails to provide any teaching or suggestion of a method by which information related to an entire *list* of RFID-tagged items can be associated with a selected category, as recited by claims 76 and 83. None of the references, either singularly or in combination, teach or suggest these elements. Parulski, for example, sequentially associates images with categories in an image-by-image basis as the images are individually captured. Garber in view of Parulski provides no teaching or suggestion of categorizing information related

to RFID tagged items in a more efficient, list-based approach where information associated with multiple items can be categorized at the same time.

Claims 48 and 95

Independent claim 48 as amended requires using an RFID reader to interrogate RFID tags, each associated with an item, wherein the items are not currently located at desired locations in a physical storage area, and the items are not current arranged or interrogated in an order associated with their desired physical locations in a storage area. Garber et al. in view of Parulski et al. fails to teach or suggest organizing information obtained from the RFID tags <u>in an order in which the items are to be moved from their current locations to their desired locations of the items in the physical storage area</u>.

In the Final Office Action, the Examiner stated that Garber et al. teaches that an algorithm is used to determine whether the scanned items are in an order. The Examiner further stated that "[s]uch determination teaches organizing information obtained from the RFID tags in an order associated with the desired location of the item in the storage area."[2] Applicant respectfully disagrees. The teachings of Garber et al. relied on by the Examiner are directed to scanning <u>presumably ordered</u> items to determine whether any of the items is actually out of order. For example, Garber et al. states: "The RFID device of the present invention could also be used to <u>verify</u> the order of materials on a shelf. . . . The device reads each item and indicates, to the operator, which items are not shelved in the correct order."[3] In contrast, Applicant's claim 48 requires interrogating RFID tags of items that are <u>not</u> currently located at their desired locations and <u>not</u> arranged or interrogated in an order associated with their desired physical locations in a storage area.

Moreover, claim 48 requires that the information obtained from the RFID tags is organized <u>in an order in which the items are to be moved from their current location to the desired locations of the items in the physical storage area</u>, and this organized information is presented to a user. As explained in the present application on pg. 9, these feature may be very useful in, for example, returning books to library shelves after use. Garber et al. provides teaching of organizing information from RFID tags into an order <u>in which the items are to be</u>

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[2] Final Office Action dated February 10, 2006, at page 20.

moved from their current locations to their desired locations in the physical storage area, thereby facilitating returning those items to the physical storage area. Instead, Garber et al. merely provides an indication to the user of any item that is not in the algorithm order.[4] Thus, to the extent the system of Garber et al. presents any information to the user, the system merely indicates any particular item that is out of order. Garber et al. makes no suggestion of presenting organized information in an order in which the items are to be moved to desired locations, as required by amended claim 48.

Similarly, with respect to claim 95, Garber et al. in view of Parulski et al. provides no teaching or suggestion of obtaining a list of information related to RFID tags organized in the order in which the RFID tags were interrogated, and organizing the information in a different order. The Examiner suggests that the Garber et al. system's function of determining whether the scanned items are in the algorithm order provides a teaching of organizing the information in an order other than the order in which the tags were interrogated by the RFID reader. Applicant disagrees. The system of Garber et al. need not reorganize the information obtained from the tags at all when determining whether a particular scanned items are in the algorithm order, and nothing in Garber et al. suggests that any such reorganization is necessary. Further, the Examiner's general assertion that "Parulski also teaches a categorization feature, which is also considered as a method of organizing because it is arrange items [sic] in a systematic plan"[5] is insufficient to show a teaching in the prior art of the particular manner in which information is obtained and organized, recited by claims 48 and 95.

Claims 18 and 91

With respect to independent claims 18 and 91, Applicant would like to clarify the differences between the cited references and the requirements of claims 18 and 91. Garber et al. in view of Parulski et al. fails to teach or suggest **ignoring** any RFID-tagged-item that may not be categorized in **any** of the categories, as recited by claims amended 18 and 91.

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[3] Garber et al., col. 17, ll. 17–21 (emphasis added).
[4] See, e.g., Garber et al., col. 19, ll. 30–31.
[5] Final Office Action dated February 10, 2006, at page 20.

In the Final Office Action, the Examiner stated that:

[A]n item that is not associated with a selected category means that the item was not categorized in that particular category and therefore, it is being ignored. Therefore, the item was not categorized in at least one category and as a result the item is being ignored. . . . [T]hose images that did not belong to the particular category [are] not downloaded or processed.[6]

Applicant respectfully disagrees with the Examiner's logic in the above excerpt, in particular with the underlined portion. In the scenario described by the Examiner, the items that are downloaded are categorized in a particular category, while the items that are "ignored" are not categorized in that particular category, but are categorized in a different category. Ignoring items that are already-categorized in a different category, as suggested by the Examiner, is not the same as ignoring items that do not fit within any category at all and are thus not even categorized, as is the case in claims 18 and 91. Parulski et al. makes no mention of images that do not fit into any category and are thus uncategorized. For at least this reason, Garber et al. in view of Parulski et al. fails to teach or suggest **ignoring** any RFID-tagged-item that may not be categorized in **any** of the categories.

Claims 39, 40, 41

In the Final Office Action, the Examiner rejected independent claims 39-41 under 35 U.S.C. 103(a) as being unpatentable over Garber et al. in view of Barritz et al. (US Patent Application Publication 2002/0008621). Applicant respectfully traverses the rejection. As further discussed below, the applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Garber et al. in view of Barritz et al. fails to teach or suggest a method of obtaining information related to items of interest associated with RFID tags, comprising (a) interrogating RFID tags, each associated with an item, to determine information related to the items, (b) performing a primary operation using the obtained information; and (c) simultaneously with the primary operation of step (b), using the same information for performing a background inventory operation of determining the presence or absence of the items in the storage area and updating an

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[6] Final Office Action dated February 10, 2006, at page 21 (emphasis added).

inventory database to reflect the determined presence or absence of the items in the storage area, as recited by amended claims 39, 40, and 41.

For example, amended claim 39 recites a primary operation of determining whether the items are in a predetermined order within a physical storage area. Amended claim 40 recites a primary operation of searching for certain items on a predetermined search list. Amended claim 41 recites a primary operation of checking items into our out of a storage area. Neither Garber et al. nor Barritz et al. teaches or suggests performing any of the above primary operations while simultaneously using the same information obtained from the RFID tags to perform the background inventory operation.

In the Final Office Action, the Examiner asserted that Garber et al. combined together with Barritz et al. teaches using information obtained by interrogating RFID tags for simultaneously performing two distinct functions. For example, the Examiner stated that "when the RFID tag is interrogated for the purpose of Barritz, wherein the tag is interrogated to determine whether the item exists in the database, the system also simultaneously, determines whether the tag belongs to a group or not."[7] Applicant can find no teaching in Barritz et al. of the system determining whether the tag belongs to a group or not, let alone any suggestion of simultaneously performing any of the recited primary operations concurrently with a background inventory operation using the same information obtained by interrogating a tag. In fact, Barritz et al. fails to teach or suggest performing a background inventory operation of determining the presence or absence of the items in the storage area to update an inventory database to reflect the determined presence or absence of the items in the storage area.

Claims 42, 45

With respect to independent claims 42 and 45, the Examiner stated in the Final Office Action that Barritz et al. teaches enabling a user to correct an inventory list in real time by creating a new inventory item. However, the Examiner appears to have overlooked the other limitations of claims 42 and 45.

For example, Garber et al. in view of Barritz et al. fails to teach determining whether an item is incorrectly represented on the inventory list as being absent, and if so, enabling the user to

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[7] Final Office Action dated February 10, 2006, at page 22.

correct the inventory list in real time by confirming the item expected to be absent is instead present, as recited by claim 42. As another example, Garber et al. in view of Barritz et al. fails to teach determining whether an item is incorrectly represented on the inventory list as being present, and if not, enabling the user to correct the inventory list in real time to confirm that the item is instead absent, as recited by claim 45.

In contrast, Barritz et al. only addresses the situation of interrogating a tag and determining that the item associated with an interrogated tag is not listed in the database of known inventory items, and enabling the user to create a new inventory item. Neither of claims 42 or 45 are directed to updating an inventory with respect to new items. With respect to claim 42, the teaching of Barritz et al. is not the same as determining whether an item is represented on the inventory list as being absent (i.e., that an entry for the item does exist in the inventory list and is expected to be absent), but the item is instead physically present. With respect to claim 45, the teaching of Barritz et al. is not the same as determining whether an item is represented on the inventory list as being present (i.e., that an entry for the item does exist in the inventory list and is expected to be present), but the item is instead physically absent. Neither Garber et al. nor Barritz et al. provides any teaching or suggestion of such features.

Dependent Claims 99 and 100

In the Final Office Action, the Examiner rejected claims 99 and 100 under 35 U.S.C. 103(a) as being unpatentable over Garber et al. in view of Parulski et al., and further in view of Barritz. Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

The Examiner stated that Barritz et al. teaches that a user may be prompted to enter descriptive information about an item, at which point a new inventory item is created. The Examiner asserted that this teaches creating a list of items that are on a predetermined ordered list but not among an ordered list, as required by claim 99, and creating a list of items that are on the ordered list but not among the predetermined ordered list, as required by claim 100. Notably, the language of both claim 99 and claim 100 requires that the created list of items contains only items that were already present on an inventory list. In contrast, as discussed above Barritz et al.

only addresses the situation of interrogating a tag and determining that the item associated with an interrogated tag is <u>not listed</u> in the database of known inventory items at all, and enabling the user to create a <u>new</u> inventory item. This is different from creating a list of items based on the differences between two other lists of items, where they newly created list of items only contains items that were already on an inventory list. Barritz et al. provides no such teaching.

The above remarks concerning independent claims 1, 8, 18, 39–42, 45, 48, 75, 76, 83, 91, and 95 also apply to dependent claims 3–7, 10–17, 19–24, 43–47, 49, 77–82, 84–90, 92–94, and 96–102 because they are dependent upon claims 1, 8, 18, 39–42, 45, 48, 75, 76, 83, 91, and 95, respectively, and thus contain all of the elements recited therein. Dependent claims 3–7, 10–17, 19–24, 43–47, 49, 77–82, 84–90, 92–94, and 96–102 are therefore allowable for at least the same reasons as independent claims 1, 8, 18, 39–42, 45, 48, 75, 76, 83, 91, or 95. For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicants' claims 1–8, 10–24, 39–49, and 75–102 under 35 U.S.C. 103(a). Withdrawal of these rejections is therefore respectfully requested.

Rejection for Obviousness-type Double Patenting:

The Examiner provisionally rejected claim 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 60 of copending Application No. 09/882,969.

The Examiner provisionally rejected claims 1-24, 48-49 and 67-74 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60 and 64-77 of copending Application No. 09/882,969.

The Examiner provisionally rejected claims 32-37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 and 42 of copending Application No. 09/755,714.

Applicants note the provisional status of this rejection. Accordingly, Applicants will address this issue if and when the rejection is formally applied.
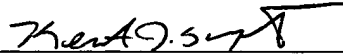
CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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